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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/679,545	11/16/2012	Robert Evan Pollin	124452.00114	5053
27557	7590	06/24/2016		
BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			EXAMINER GOTTSCHALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3693	
			NOTIFICATION DATE	DELIVERY MODE
			06/24/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Belay@blankrome.com
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IPR2024-01159
Ex. 3003

Office Action Summary	Application No. 13/679,545	Applicant(s) POLLIN ET AL.	
	Examiner MARTIN GOTTSCHALK	Art Unit 3693	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/10/2015.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-6 and 11-30 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-6 and 11-30 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

- a) ☐ All b) ☐ Some c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/22/2016</u> . | 4) ☐ Other: ____. |

DETAILED ACTION

Notice to Applicant

1. The present application is being examined under the pre-AIA first to invent provisions.
2. Claims 1-6 and 11-30 have been examined. Claims 7-10 are cancelled.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/10/2015 has been entered.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-6 and 11-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claims as a whole,

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considering all claim elements both individually and in combination, do not amount to significantly more than an abstract idea.

The claims are directed to the abstract idea of authenticating a payer and authorizing a payment without allowing the payee direct access to financial account information of the payer. This is done by using third-parties to separate identity and account information such that requests and authorizations for payments are made through the third parties. This is considered to be abstract because it is an idea standing alone such as a plan or scheme. The claims are similar to obtaining and comparing intangible data (*Cybersource*), a concept the courts have found to be abstract because it is an idea of itself. The claims are also similar to the concept of mitigating settlement risk, which the court in the *Alice* decision determined was an abstract idea because it was a fundamental economic practice.

The steps of exemplary claim 1 recite limitations which implement the abstract idea. Steps a-d recite generating and storing intangible data (e.g. a token). Step e recites comparing the intangible data to authorize a payment.

The claim recites certain additional elements pertaining to technology such as an electronic system; first and second computing systems; the Internet; a communications link; an electronic data token; and a payment processing system. These elements refer to generic software and hardware structures, knowledge of which would have been

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prevalent and readily available to those in the related industry. They are recited at a high-level to perform conventional functions such as storing, receiving, and transmitting information. When considered individually, these elements do not add significantly more to the abstract idea. When considered as a whole, they merely reflect performance of the idea of itself in a particular technological environment such as the Internet, which is not considered to be significantly more than the abstract idea.

Consideration of the dependent claims fails to remedy the situation. Therefore claims 1-6 and 11-30 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Response to arguments under 35 U.S.C. 101

A. On pages 13-15 of the current response, Applicant generally argues that the claims are not directed to the abstract idea described in the last office action, because, for instance, they recite, "...particular structure, sequence, and methods of accomplishing a broad goal..." Applicant further discusses the ideas felt to characterize the invention such as separating the enrollment process into two phases and using two different communication channels.

In response, the Examiner directs Applicant to the rejection above, which provides certain details addressing Applicant concerns. As an aside, the Examiner considers many of Applicant's remarks here to only further underscore the point that the invention is primarily directed to an abstract idea of itself. For instance, it appears Applicant is

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arguing that the essence of the invention is that it solves a problem by manipulating or separating information flow, which indeed appears to be an abstract idea. The purported specificity of steps and structure only appear to be vehicles by which the abstract concept is technologically implemented.

B. On page 13, Applicant appears to argue that the claims do not attempt to monopolize the abstract idea, and thus should be considered to be patent-eligible.

In response, Applicant must realize that degree of monopolization is not the standard by which eligibility is determined, but rather it is the two step *Mayo/Alice* analysis, as applied above.

Claim Rejections - 35 USC § 112

6. The following is a quotation of 35 U.S.C. 112(b):
(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection under this section are HEREBY WITHDRAWN in view of Applicant's acknowledgement of the Examiner's understanding of the term "contemporaneously."

Prior Art Rejections

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7. The prior art rejections are HEREBY WITHDRAWN in view of Applicant's arguments.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN GOTTSCHALK whose telephone number is (571)272-7030. The examiner can normally be reached on Mon - Fri 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shahid R. Merchant can be reached on (571) 270-1360. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. G./

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Examiner, Art Unit 3693

/KENNETH BARTLEY/

Primary Examiner, Art Unit 3693